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EXAMINER

FLETCHER, JAMES A

| ART UNIT | PAPER NUMBER |
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2616

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,470

Applicant(s)

NAKAHARA ET AL.

Examiner

James A. Fletcher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims recite "A computer signal embodied in a carrier wave and representing a series of instructions..." This recitation is non-statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-4, 6, 8, 10-11, 13-14, 16-17, 19, 21-22, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Itoh et al (6,700,989).

Regarding claims 1 and 11, Itoh et al disclose an information recording apparatus and method comprising:

- a device and process for specifying a division timing in the recording information (Col 31, lines 25-27 "a computer user who is an expert having moving-image editing tools can manipulate the moving image data");

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- a device and process for recording in the recording medium front part record information that is the record information before the specified division timing and rear part record information that is the record information after the specified division timing (Col 31, lines 15-16 "the moving image is stored by the computer, and that the resulting data file is transferred or duplicated");
- a device and process for generating permission information indicating whether or not to permit at least one of the front and rear part record information to be further divided (Col 5, lines 62-65 a copy-restriction-information insertion unit by which information indicative of a restriction on the copying of the moving image is inserted into an area where control data for the moving image are recorded"); and
- a device and process for recording the generated permission information in the recording medium (Col 9, lines 28-32 "The moving image in which the watermark information and the copy restriction information have been inserted in accordance with the present invention, is stored in any of various storage media").

Regarding claims 3 and 13, Itoh et al disclose an information recording apparatus and method comprising:

- a device and process for detecting the permission information recorded in the recording medium (Col 31, lines 46-49 "the copy control information contained in the read-out/received data controls if the moving image is to be actually

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outputted [to be recorded or/and displayed], so as to permit or bar the image output");

- a device and process for changing the content of the detected permission information (Col 28, lines 4-7 "in the one-copy mode, a child [a copy] can be formed, but the formed copy is set in the no-more-copy mode, so that a copy corresponding to a grandchild cannot be formed"); and
- a device and process for overwriting the changed permission information on the recording medium (Col 9, lines 28-32 "The moving image in which the watermark information and the copy restriction information have been inserted in accordance with the present invention, is stored in any of various storage media").

Regarding claims 4 and 14, Itoh et al disclose an information recording apparatus and method comprising:

- a device and process for detecting permission information from a recording medium having record information and permission information (Col 31, lines 46-49 "the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output") indicating whether or not to permit execution of edit processing for dividing the record information into two or more items of partial record information recorded therein (Fig. 24 illustrates the several copy modes, and the permissions they indicate to the reproduction and copying apparatus);

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- a device and process for judging the content of the detected permission information (Col 31, lines 46-49 “the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output”); and
- a device and process for only when the judged content corresponds to the content in which the division processing is enabled, executing the edit processing (Col 31, lines 46-49 “the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output”).

Regarding claims 6 and 16, Itoh et al disclose an information recording apparatus and method comprising:

- a device and process for specifying a division timing to divide the record information (Col 31, lines 25-27 “a computer user who is an expert having moving-image editing tools can manipulate the moving image data”);
- a device and process for dividing the record information into front and rear part record information (Col 31, lines 25-27 “a computer user who is an expert having moving-image editing tools can manipulate the moving image data”); and
- a device and process for generating permission information having the same content as the permission information recorded in the medium before division, relevant to each of the front and rear record information, then recording the

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information in the recording medium (Col 34, lines 32-34 "In the conventional case free from the copy restriction [in the any-copy mode], the number of children is infinite, and the number of generations is also infinite").

Regarding claims 8 and 10, Itoh et al disclose an information recording apparatus wherein the recording medium comprises a DVD capable of information recording (Col 4, lines 32-33 "This standard is chiefly directed toward DVDs").

Regarding claim 17, Itoh et al disclose an information recording medium comprising:

- a record information area having one or plural items of recording information recorded therein (Col 1, lines 13-15 "moving images which are distributed as being accumulated and recorded in package type media"); and
- a permission information recording region having permission information indicating whether or not to permit execution of edit processing for dividing each item of recording information into one or more items of partial record information (Col 8, lines 52-57 "according to the present invention, a medium drive [for example, a DVD drive] is enabled to permit or bar the video recording or duplication of the moving image, in such a way that a copy restriction code is previously recorded in a control-data storage area within the moving-image storage medium or within communication data).

Regarding claims 19 and 25, Itoh et al disclose an information recording medium and computer data signal embodied in a carrier wave containing a recording control program for functioning a recording computer contained in an information

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recording apparatus for recording target record information in a recording medium (Col 8, lines 49-51 "the computer program for creating the watermarked moving image is also realized for the first time by the present invention"), the recording control program causing the recording computer to function as:

- a device and step for specifying a division timing in the recording information (Col 31, lines 25-27 "a computer user who is an expert having moving-image editing tools can manipulate the moving image data");
- a device and step for recording in the recording medium front part record information that is the record information before the specified division timing and rear part record information that is the record information after the specified division timing (Col 31, lines 15-16 "the moving image is stored by the computer, and that the resulting data file is transferred or duplicated");
- a device and step for generating permission information indicating whether or not to permit at least one of the front and rear part record information to be further divided (Col 5, lines 62-65 a copy-restriction-information insertion unit by which information indicative of a restriction on the copying of the moving image is inserted into an area where control data for the moving image are recorded"); and
- a device and step for recording the generated permission information in the recording medium (Col 9, lines 28-32 "The moving image in which the watermark information and the copy restriction information have been

inserted in accordance with the present invention, is stored in any of various storage media").

Regarding claim 21, Itoh et al disclose having a recording control program causing a recording computer to function as:

- a device for detecting the permission information recorded in the recording medium (Col 31, lines 46-49 "the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output");
- a device for changing the content of the detected permission information (Col 28, lines 4-7 "in the one-copy mode, a child [a copy] can be formed, but the formed copy is set in the no-more-copy mode, so that a copy corresponding to a grandchild cannot be formed"); and
- a device for overwriting the changed permission information on the recording medium (Col 9, lines 28-32 "The moving image in which the watermark information and the copy restriction information have been inserted in accordance with the present invention, is stored in any of various storage media").

Regarding claims 22 and 26, Itoh et al disclose an information recording medium and computer data signal embodied in a carrier wave containing a recording control program (Col 8, lines 49-51 "the computer program for creating the watermarked moving image is also realized for the first time by the present invention") causing a recording computer to function as

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- a device and process for detecting permission information from a recording medium having record information and permission information indicating whether or not to permit execution of edit processing (Col 31, lines 46-49 “the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output”) for dividing the record information into two or more items of partial record information recorded therein (Col 31, lines 25-27 “a computer user who is an expert having moving-image editing tools can manipulate the moving image data”);
- a device and process for judging the content of the detected permission information (Col 31, lines 46-49 “the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output”); and
- a device and process for only when the judged content corresponds to the content in which the division processing is enabled, executing the edit processing (Col 31, lines 46-49 “the copy control information contained in the read-out/received data controls if the moving image is to be actually outputted [to be recorded or/and displayed], so as to permit or bar the image output”).

Regarding claim 24, Itoh et al disclose an information-recording medium having recorded therein a recording control program causing a recording computer to function as:

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- a device for specifying a division timing to divide the record information (Col 31, lines 25-27 "a computer user who is an expert having moving-image editing tools can manipulate the moving image data");
- a device for dividing the record information into front and rear part record information after the specified division timing (Col 31, lines 25-27 "a computer user who is an expert having moving-image editing tools can manipulate the moving image data"); and
- a device for generating permission information having the same content as the permission information recorded in the recording medium before being divided, relevant to each of the front and rear part record information, and recording the information in the recording medium (Col 34, lines 32-34 "In the conventional case free from the copy restriction [in the any-copy mode], the number of children is infinite, and the number of generations is also infinite").

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al.

Regarding claims 7 and 9, Itoh et al disclose an information recording apparatus wherein the record information comprises music information (Col 2, lines 59-

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61 "copyright administration services for still images and music that utilize electronic watermarks"), but does not specifically disclose that the audio information contains voice information as well.

The examiner takes official notice that music and voice are notoriously well-known and widely used types of audio information, being used in a multitude of recording genres, channels, and formats.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Itoh et al to specify audio data as including music and voice information.

7. Claims 2, 5, 12, 15, 18, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al as applied to claims above, and further in view of Kikuchi et al (6,577,811).

Regarding claims 2, 5, 12, 15, 18, 20, and 23, Itoh et al are silent on the topic of erasing data from a medium after performing editing of that data.

Kikuchi et al teach an information recording apparatus and method wherein the permission information takes any one of:

- a first state in which it is enabled that at least either one of the front and the rear record information is erased from the recording medium after [being] recorded (Col 69, lines 50-56 "D-PRO 36X...erases data [files or VTS] recorded on disc 10X under the control of microcomputer block [MPU] 30X"), and that the information is further divided (Col 71, line 66 - Col 72, line 3 "MPU 30X...has an erase prohibition range specification function, erase

prohibition setting function, cell divide function, and erase prohibition detection function for cell units, thus improving the operability of the system for the user”);

- a second state in which it is disabled that the information is erased from the recording medium after [being] recorded (Col 69, lines 7-9 “a program which has already been played back but is to be kept can be prevented from being inadvertently erased by, e.g., overwrite by setting the archive flag”), but it is enabled that the information is further divided (Col 71, line 66 - Col 72, line 3 “MPU 30X...has an erase prohibition range specification function, erase prohibition setting function, cell divide function, and erase prohibition detection function for cell units, thus improving the operability of the system for the user”); and
- a third state in which it is disabled that the information is erased from the recording medium after [being] recorded (Col 69, lines 50-56 “D-PRO 36X...erases data [files or VTS] recorded on disc 10X under the control of microcomputer block [MPU] 30X”), and that the information is further divided (Col 71, line 66 - Col 72, line 3 “MPU 30X...has an erase prohibition range specification function, erase prohibition setting function, cell divide function, and erase prohibition detection function for cell units, thus improving the operability of the system for the user”).

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As taught by Kikuchi et al, various states of allowing erasure of copied data are well known and widely used, providing a user with the ability to restore useful storage media for storage of alternate data.


Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Itoh et al to incorporate a variety of possible erasure conditions for copied material.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (571) 272-7377. The examiner can normally be reached on 7:45-5:45 M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAF
3 August 2005


James J. Groody
Supervisory Patent Examiner
Art Unit 2622 2616